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MAR 18 2002

OFFICE OF PETITIONS

In re Application of
Ristic, Bhadula, Yang, Elthon, and :
Habben : DECISION GRANTING PETITION
Application No. 09/810,764 : UNDER 37 CFR 1.78(a)(6)
Filed: 16 March, 2001 : AND REFUSING STATUS
Attorney Docket No. P03965US1 : UNDER 37 CFR 1.47(a)

This is in response to the petition filed under 37 CFR 1.47(a)¹ on 9 January, 2002. This is also a decision on the petition under 37 CFR 1.78(a)(6) to accept a late claim of the benefit of a prior provisional application under 35 U.S.C. § 119(e) filed on 10 December, 2001.

The petition under 37 CFR 1.78(a)(6) is GRANTED.

The petition under 37 CFR 1.47(a) is DISMISSED.

Receipt is acknowledged of the Application Data Sheet (ADS) filed by facsimile on 4 March, 2002, identifying prior provisional Application No. 60/204,204, filed on 11 May, 2000, is acknowledged.

Rule 47 applicant is given TWO MONTHS from the mailing date of

¹A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C.

§§ 115 and 116;

- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 16 March, 2001, without an executed oath or declaration. Accordingly, on 2 May, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Application, requiring a signed oath or declaration and a surcharge for its late filing. In response, on 9 January, 2002 (certificate of mailing date 22 October, 2001), petitioners filed an executed declaration naming Zoran Ristic, Shailendra K. Bhadula, Genping Yang, Thomas E. Elthon, and Jaffrey E. Habben as joint inventors and signed by joint inventors Ristic, Bhadula, Elthon, and Habben on behalf of themselves and joint inventor Yang. The present petition, also filed on 9 January, 2002, asserts that Yang was sent a copy of the application but the application was returned by the U.S. Postal Service.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5).

In regards to item (1) and (5), petitioners have not shown that diligent efforts have been made to locate the non-signing inventor at his last known address.² The last known address

²MPEP 409.03(d).

should be the address at which the inventor customarily receives mail, will ordinarily be the last known residence of the nonsigning inventor.³ In this case, the declaration of Patricia E. Wilson states that one of the other inventors, Dr. Ristic, stated to her that Dr. Yang was no longer employed by the University of South Dakota, which is given as Yang's last known address. Obviously, Dr. Yang is no longer receiving mail at this address.

A diligent effort to contact Yang would therefore involve attempting to determine the current residence of Yang, and, if a new address for Yang is found, attempting to contact him there by giving or sending him a copy of the application papers (specification, including claims, drawings, if any, and the declaration) at that address. A brief Internet search reveals that Dr. Yang may reside at another address in Vermillion, SD.

If the application is returned as undeliverable, petitioners should submit a copy of the envelope showing that the envelope addressed to the non-signing inventor at his last known address was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor must be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Petitioner should also explain what attempts were made to obtain a forwarding address and to locate each inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. through e-mail or the telephone) continue to fail, then applicant will have established that the inventor cannot be reached.

If the inventor refuses in writing to sign the declaration after having been sent or given a copy, petitioners should submit a copy of the written refusal with any renewed petition. If a refusal is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), petitioner has not submitted a proper oath or declaration in compliance with 37 CFR 1.63. The mailing address provided in the declaration for Dr. Yang is the address of his former employer. In situations where an inventor does not execute the oath or declaration, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the

³MPEP 409.03(e).

inventor. A new oath or declaration, signed by all the signing inventors,⁴ is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

The application is being forwarded to the Office of Initial Patent Examination for correction of Office PALM records to indicate that this application claims priority from Application No. 60/203,204, and for issuance of a corrected filing receipt. Thereafter, the application file will be returned to the Office of Petitions to await petitioners' response to the dismissal of the petition under 37 CFR 1.47(a).

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy